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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,131	09/22/2003	Kjell Andersson	1103326-0573	2867

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WHITE & CASE LLP
PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

WEDDINGTON, KEVIN E

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/669,131

Applicant(s)

ANDERSSON, KJELL

Examiner

Kevin E. Weddington

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/341,904.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

CLAIMS 1-11 ARE PRESENTED FOR EXAMINATION.

APPLICANT'S PRELIMINARY AMENDMENT AND INFORMATION DISCLOSURE STATEMENT FILED
SEPTEMBER 23, 2003 HAVE BEEN RECEIVED AND ENTERED.

DOUBLE PATENTING

A REJECTION BASED ON DOUBLE PATENTING OF THE "SAME INVENTION" TYPE FINDS ITS SUPPORT IN THE LANGUAGE OF 35 U.S.C. 101 WHICH STATES THAT "WHOEVER INVENTS OR DISCOVERS ANY NEW AND USEFUL PROCESS ... MAY OBTAIN A PATENT THEREFOR ..." (EMPHASIS ADDED). THUS, THE TERM "SAME INVENTION," IN THIS CONTEXT, MEANS AN INVENTION DRAWN TO IDENTICAL SUBJECT MATTER. SEE *MILLER V. EAGLE MFG. CO.*, 151 U.S. 186 (1894); *IN RE OCKERT*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); AND *IN RE VOGEL*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A STATUTORY TYPE (35 U.S.C. 101) DOUBLE PATENTING REJECTION CAN BE OVERCOME BY CANCELING OR AMENDING THE CONFLICTING CLAIMS SO THEY ARE NO LONGER COEXTENSIVE IN SCOPE. THE FILING OF A TERMINAL DISCLAIMER CANNOT OVERCOME A DOUBLE PATENTING REJECTION BASED UPON 35 U.S.C. 101.

CLAIMS 1-6 AND 8-11 ARE REJECTED UNDER 35 U.S.C. 101 AS CLAIMING THE SAME INVENTION AS THAT OF CLAIMS 1-8 OF PRIOR U.S. PATENT No. 6,258,850.

THE PRESENT APPLICATION AND THE PATENTED APPLICATION ARE CLAIMING THE SAME INVENTION:

COMPOUNDS OF 3-ARYL-2-HYDROXYPROPIONIC ACID DERIVATIVES OF FORMULA I, A
PROCESS AND INTERMEDIATED FOR ITS MANUFACTURE, PHARMACEUTICAL PREPARATIONS
CONTAINING IT AND THE METHOD FOR USING THE COMPOUNDS IN CLINICAL CONDITIONS ASSOCIATED
WITH INSULIN RESISTANCE.

THIS IS A DOUBLE PATENTING REJECTION.

CLAIMS 1-6 AND 8-11 ARE NOT ALLOWED.

CLAIM REJECTIONS - 35 USC § 101

35 U.S.C. 101 READS AS FOLLOWS:

WHOEVER INVENTS OR DISCOVERS ANY NEW AND USEFUL PROCESS, MACHINE, MANUFACTURE, OR COMPOSITION OF MATTER, OR ANY NEW AND USEFUL IMPROVEMENT THEREOF, MAY OBTAIN A PATENT THEREFOR, SUBJECT TO THE CONDITIONS AND REQUIREMENTS OF THIS TITLE.

CLAIM 7 IS REJECTED UNDER 35 U.S.C. 101 BECAUSE THE CLAIMED INVENTION IS DIRECTED TO NON-STATUTORY SUBJECT MATTER AND IS NOT BEING EXAMINED ON THE MERITS.


THE PHRASE "USE OF" IN CLAIM 7 IS NOT AN ACCEPTABLE CLAIM LANGUAGE TERM USED IN THE U.S. PATENT OFFICE. APPLICANT MAY WISH TO AMEND CLAIM 7 TO RECITE "A METHOD OF USE" OR "A COMPOSITION".

CLAIM 7 IS NOT ALLOWED.

ANY INQUIRY CONCERNING THIS COMMUNICATION OR EARLIER COMMUNICATIONS FROM THE EXAMINER SHOULD BE DIRECTED TO KEVIN E. WEDDINGTON WHOSE TELEPHONE NUMBER IS (571) 272-0587. THE EXAMINER CAN NORMALLY BE REACHED ON 11:00 AM-7:30 PM.

IF ATTEMPTS TO REACH THE EXAMINER BY TELEPHONE ARE UNSUCCESSFUL, THE EXAMINER'S SUPERVISOR, CHRISTOPHER LOW CAN BE REACHED ON (571) 272-0953. THE FAX PHONE NUMBER FOR THE ORGANIZATION WHERE THIS APPLICATION OR PROCEEDING IS ASSIGNED IS 703-872-9306.

INFORMATION REGARDING THE STATUS OF AN APPLICATION MAY BE OBTAINED FROM THE PATENT APPLICATION INFORMATION RETRIEVAL (PAIR) SYSTEM. STATUS INFORMATION FOR PUBLISHED APPLICATIONS MAY BE OBTAINED FROM EITHER PRIVATE PAIR OR PUBLIC PAIR. STATUS INFORMATION FOR UNPUBLISHED APPLICATIONS IS AVAILABLE THROUGH PRIVATE PAIR ONLY. FOR MORE INFORMATION ABOUT THE PAIR SYSTEM, SEE [HTTP://PAIR-DIRECT.USPTO.GOV](http://PAIR-DIRECT.USPTO.GOV). SHOULD YOU HAVE QUESTIONS ON ACCESS TO THE PRIVATE PAIR SYSTEM, CONTACT THE ELECTRONIC BUSINESS CENTER (EBC) AT 866-217-9197 (TOLL-FREE).


KEVIN E. WEDDINGTON
PRIMARY EXAMINER
ART UNIT 1614

K. WEDDINGTON
SEPTEMBER 13, 2004